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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,510

01/06/2004

Robert W. Jones

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07/10/2006

LITMAN LAW OFFICES, LTD  
PO BOX 15035  
CRYSTAL CITY STATION  
ARLINGTON, VA 22215

EXAMINER

DRODGE, JOSEPH W

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/751,510

**Applicant(s)**

JONES, ROBERT W.

**Examiner**

Joseph W. Drodge

**Art Unit**

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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The Declaration filed on June 28, 2006 under 37 CFR 1.131 has been considered and, in combination with consideration of the file copy of the Declaration presented during the Personal Interview of June 7, 2006, is now deemed effective to overcome the Groth et al reference.

The indicated allowability of claims 12-20, in view of swearing back of the Groth reference with the June 28, 2006 Declaration, is withdrawn in view of the newly discovered reference(s) to Homa patent 3,507,396. Rejections based on the newly cited reference(s) follow.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12,13,15-17,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan patent 3,855,132 in view of Home patent 3,507,396, newly cited. Dugan discloses a foam filter insert 2, of open cell foam material (Abstract and column 2, lines 21-26), combined with a gutter 5 having all of the cross-sectional features of filter insert and gutter of the instant claims, including angled or triangular sides 7 between front edge of outer portion of upper side and lower side that is forward of rear edge of lower side, so as to generally correspond to the generally triangular shape of outer surface of the corresponding gutter, while leaving some void space between filter insert and lower and outer sides of the gutter (see especially figure 1 and column 1, lines 56-60).

Dugan, in each of the figure 1 and figure 2 embodiments, disclose the filter insert having a generally horizontal upper side 6 (see column 2, lines 5-7), generally vertical rear side 5 that is perpendicular to the upper side and bearing against the rear side of the gutter, and a lower side parallel with the upper side, and bearing against the gutter lower wall in the figure 1 embodiment, and a planar, or generally flat angled side extending downwardly and inwardly towards the lower filter insert side from the front edge of the upper side of the filter insert, such front edge being adjacent the gutter front wall upper lip. The general form of the filter insert of Dugan approximates a combination of an upper truncated right triangular prism with a lower rectangular prism.

In the figure 1 embodiment, a filter insert configuration that allows free flow of liquid is provided by way of forming the filler with a pre-cut slot on its lower side or manufacturing it to not extend all the way to the gutter bottom while being supported by spaced supports 7 (see column 2, lines 9-20).

In the figure 2 embodiment, the filter insert is configured and manufactured to essentially fill the entire inner volume of the gutter. It is stated that the filter insert may either be manufactured to be cut to the gutter shape or may alternatively, be cut to a larger size and compressed to fit the trough of the gutter.

The claims differ in requiring the insert to have the overall form of a truncated right triangle, where the angled side extends all the way downwardly and inwardly to a forward edge of the lower side of the gutter insert, and such as to leave a void having a substantially triangular-shaped cross section between the bottom and front walls of the gutter and the angled side of the insert.

Homa teaches such outer angled surface of a gutter guard or filter insert (figure 6 and column 2, lines 12-30) substantially extending all the way from upper side of the filter insert adjacent upper lip of the gutter to the lower side of the filter insert and imparting a general form of a truncated right triangle for the elongated filter insert. The gutter guard of Homa is deemed to constitute a filter and thus is analogous since column 1, lines 37-44 teach the guard as excluding passage of solid matter including leaves while permitting passage of rainwater and column 2, lines 13-20 teach the gutter guard or filter as comprised of mesh material having distinct apertures for passage of water. This feature is clearly shown as leaving a instantly claimed triangularly shaped void space 44 between bottom and outer walls 62,64 of gutter 2 and angled outer surface 42a of filter insert (figure 2 and column 5, lines 28-44). Such feature of Homa is taught as providing for unimpeded flow of rainwater and matter suspended therein along the bottom of the gutter at column 2, lines 27-30.

It would have been obvious to one of ordinary skill in the art to have manufactured the filter insert of Dugan to contain such angled side as taught by Homa, so as to more clearly provide unimpeded flow of rainwater and any suspended matter therein which is not captured by the Dugan filter, column 2, lines 27-30 providing such express motivation.

As to claim 16, especially figure 1 of Dugan and figure 6 of Homa also show a gutter inner lip portion extending downward and then inward

For claim 17, figure 1 of Dugan as well as the figures of Homa also illustrate the gutter and filter insert being located below the draining eave of 4 of a roof.

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Regarding claim 13, requiring foam material to have 10 to 20 cells per square inch, such limitation is taught by Dugan at column 2, lines 36-38.

Regarding claims 15 and 19, Dugan teaches a gutter filter insert with four foot lengths of foam at column 2, lines 27-34.

For claim 20, Dugan also discloses the filter insert being readily placed or fitted into the trough of gutter walls (column 1, lines 56-60 and 26-28, hence also removable from the gutter

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Homa as applied to claims 12 and 13 and further in view of Etani patent 3,946,362 of record. Claim 14 specifies polyether foam, Dugan teaching polyurethane foam and Etani teaching that polyether foam is a component of polyurethane foam filters. It would have been obvious to have utilized polyether or polyurethane foam for the filter insert of Dugan, as taught by Etani, since these materials are readily available and easily manufactured and processed.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Homa as applied to claims 12 and 13 and further in view of Hunt patent 5,103,601 of record. Claim 18 differs in requiring gutter spikes extending through the gutter upper lip to secure gutter to building structure. Hunt provides such spikes 40 (see column 2, lines 60-64). It would have been further obvious to one of ordinary skill in the art to have utilized the spikes of Hunt in the installation of gutter and insert of Dugan, in order to firmly secure gutter to building so that it does not fall off.

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Applicant's arguments with respect to claims 12-20 have been considered but are moot in view of the new ground(s) of rejection.

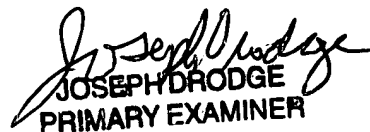
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

July 6, 2006

  
JOSEPH DRODGE  
PRIMARY EXAMINER